REMARKS

Claims 27-52 are pending in the application.

Claims 27-52 are rejected.

Reconsideration and allowance of claims 27-52 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §102

Claims 27-41 and 46-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Lai et al (U.S. 2004/0193648) ("Lai"). Applicant respectfully traverses this rejection on the grounds that the reference fails to teach every element of any rejected claim.

Claim 27 includes "retrieving digital media content from a content provider, performing a digital rights management function associated with an authorized user resulting in authorized digital media content, storing the authorized digital media content on the computer system, and providing the authorized digital media content via a user interface to a thin media client without performing a digital rights management function on the thin media client."

The USPTO provides in MPEP §2131 that: "To anticipate a claim, the reference must teach every element of the claim."

Therefore, to support these rejections with respect to claim 27, Lai must contain all of the above-claimed elements. However, this patent does not teach a single computer system that retrieves digital media content, performs a digital rights management function associated with an authorized user, and stores the authorized digital media content. Instead, Lai teaches a collection of servers for fetching, transcoding, and streaming media content to the viewer client. According to Lai, a "machine farm 216 includes a plurality of individual servers" including "transmitter servers 220 that fetch the source data for the requested media content, transcoder servers 218 that transcode the source data to the appropriate destination type, and streaming servers 222 that stream the transcoded media content to the viewer client 102." As such, the Lai patent does not teach retrieving digital media content from a content provider, performing a digital rights management function associated with an authorized user resulting in authorized digital media content, storing the authorized digital media content on the computer system, and providing the authorized digital media content via a user interface to a thin media client without

performing a digital rights management function on the thin media client, all performed by the same computer system. For at least this reason, the previous rejections based on 35 U.S.C. §102(b) cannot be supported by Lai as applied to independent claims 27, 40 and 46, and the claims that depend therefrom.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 42 – 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai, in view of John C. Platt (U.S. 6,987,221) (Platt). Applicant respectfully traverses this rejection on the grounds that the combination of references fails to teach every limitation of any rejected claim, and therefore fails to present a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

> The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach all limitations of the rejected claims.

Rejection of Claims based on Lai and Platt

Claims 42 – 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai, in view of Platt. Applicant respectfully traverses this rejection on the grounds that the combination of references fails to teach every limitation of any rejected claim, and therefore fails to present a *prima facie* case of obviousness.

As discussed above, Lai fails to teach key limitations of claim 40, from which claims 42-45 depend. Even if Platt teaches a system and method to generate a playlist, Platt teaches nothing to overcome the deficiencies of Lai and the Examiner has made no argument to the contrary. Applicant thus submits that the combination of references fails to teach all limitations of any rejected claim.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

References Do Not Teach the Desirability of the Combination

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

> [T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests all limitations of the rejected claims. Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claim(s) 27, 40 and 46, and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 27-52 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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Dated: 3-29-07

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